

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Norman P. Formo Attorney Docket No. FPMI114707
Application No.: 09/520,947 Group Art Unit: 1761
Filed: March 8, 2000 Examiner: Robert A. Madsen
Title: DOUBLE BAGGING SYSTEM

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TC 1700

TRANSMITTAL OF APPELLANT'S REPLY BRIEF/
REQUEST FOR ORAL HEARING

Seattle, Washington 98101

September 2, 2003

TO: THE COMMISSIONER FOR PATENTS
THE BOARD OF PATENT APPEALS AND INTERFERENCES

Enclosed herewith for filing in the above-identified application are:

1. Applicant's Reply Brief.
2. Applicant's Request for Oral Hearing Under 37 C.F.R. § 1.194.
3. Check No. 150540 to cover the fee for the Request for Oral Hearing.

The Commissioner is hereby authorized to charge any fees which may be required during the entire pendency of the application, or credit any overpayment, to Deposit Account No. 03-1740. This authorization also hereby includes a request for any extensions of time of the appropriate length required upon the filing of any reply during the entire prosecution of this application. A copy of this sheet is enclosed.

Respectfully submitted,

CHRISTENSEN O'CONNOR
JOHNSON KINDNESS^{PLLC}

Thomas M. Donahue, Jr.

Registration No. 43,590

Direct Dial No. 206.695.1738

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APPLICANT'S REQUEST FOR ORAL HEARING UNDER 37 C.F.R. § 1.194

Seattle, Washington 98101

September 2, 2003

TO THE BOARD OF PATENT APPEALS AND INTERFERENCES:

Applicant hereby requests oral hearing in the above-identified matter on appeal. Check number 150540 in the amount of \$140.00 is enclosed to cover the request for oral hearing.

Respectfully submitted,

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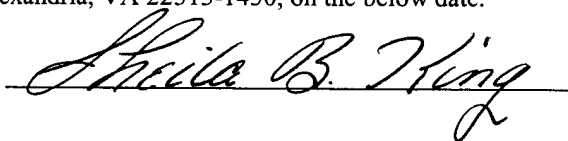


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APPLICANT'S REPLY BRIEF

Seattle, Washington 98101

September 2, 2003

TO THE BOARD OF PATENT APPEALS AND INTERFERENCES:

The Examiner has objected to Appellant's grouping of the claims and maintains his objections to the allowability of all of Applicant's claims.

Grouping the Claims

With respect to the grouping of claims, 37 C.F.R. § 1.192(c)(7) requires the claims be grouped based on each ground of rejection used by the Examiner. The grouping suggested by Appellant follows the grouping identified by the Examiner, both during the examination and at Section 10 of the Examiner's Answer. The Examiner now proposes another grouping at Section 7 and states that this grouping applies because "appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof." Appellant's brief contains no such statement because neither the Examiner or Appellant had ever suggested the grouping now proposed by Examiner. Furthermore, Examiner's proposed grouping fails because the claims he groups are not based upon the same grounds of rejection.

As an example, the Examiner now includes Claims 25 and 29 within the same group. However, the Examiner's own description of the grounds of rejection at section 10 of his answer shows that these claims were rejected on different grounds. Claim 25 is rejected under 35 U.S.C. § 103(a) over Morris in view of McEachen and Theed. Claim 29 is rejected under 35 U.S.C. §

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103(a) over Morris in view of McEachen and Theed, further in view of Collins, further in view of Blum. The Examiner's newly proposed grouping fails because it does not conform to each ground of rejection contested by Appellant.

Argument

CLAIMS 25, 26, 30 and 31

In responding to Applicant, the Examiner acknowledges that obviousness can only be established by combining or modifying the teachings of the prior art where there is some teaching, suggestion, or motivation to do so within either the prior art or in knowledge generally available to one of ordinary skill in the art. Examiner's Answer at p. 4. What is wholly missing from the Examiner's Answer is any indication of where that teaching, suggestion, or motivation is found within either the prior art or knowledge generally available to one of ordinary skill in the art. Instead of actually identifying the motivation within the prior art, the Examiner has simply said his cited references provide such motivation. Absent some evidence, the Examiner has not met his burden of showing how the prior art provides some teaching or motivation to develop the invention claimed by Applicant. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300, 1301 (Bd. Pat. App. Int. 1993).

The Examiner has agreed that his primary reference, Morris, teaches neither feeding the bread into a first bag with a closed end having a weakening opening means nor heat shrinking the inner bag. *Id.* The Examiner then turns to McEachen, which has a single bag that is configured to be openable at either end, and claims, *without any citation to McEachen*, that it provides motivation to substitute the single bag of McEachen for the inner wrap of Morris. *Id.* at p. 5. In fact, McEachen provides absolutely no such suggestion. There is no language in McEachen which would lead one to believe its single bag could be substituted for the inner wrap of Morris.

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Instead of identifying where the prior art provides the suggestions to substitute, the Examiner has simply continued to assume that bags and wrappings are interchangeable "packages." This assumption, which was addressed in Applicant's Brief but remains unsupported in the Examiner's Reply, is contradicted by the very prior art on which the Examiner relies.

Morris teaches directly away from the Examiner's suggestion that bags and wrappings are interchangeable "packages." According to Morris, a wrapping has the function of firmly maintaining the loaf in its original conformation so that the individual slices are held in position. Morris at Col. 2, lines 12 – 14. "As a result, the loaves can be stacked during shipment and on retail display racks without squashing the individual slices." *Id.* at lines 14 – 17. Morris also teaches that

bag-type bread packages have at least two major disadvantages to the retailer. In the first place, it is not practicable to form and close a bag so that it tightly confines the slices of bread. Rather, these slices are free to move relative to one another within the bag. The loaf in effect becomes limp and the individual slices are free to move relative to one another in the bag. As a result, it is not feasible to stack a number of these loaves on a display rack.

Morris at Col. 1, lines 51 – 59. Contrary to the Examiner's suggestion, the prior art actually teaches that a bag cannot be simply substituted for a wrapper, and that these "packages" have different functions.

Moreover, Applicant has not, as Examiner suggests, simply attacked the references individually. *In re Merck & Co.*, 800 F.2d 1091, 231 U.S.P.Q. 375, 380 (Fed. Cir. 1986), instructs that the prior art references must be considered for what they *fairly* teach in combination with the rest of the prior art. In this case the prior art consistently teaches that wrappers and bags are different kinds of packaging with different functions and they cannot simply be substituted for one another. Rather than follow the teachings of the prior art, the

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Examiner has picked passages or specific aspects of each reference without considering what the references as a whole would teach to a person skilled in the art.

As the Federal Circuit has held, "the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1380, 1783 - 84 (Fed. Cir. 1992). Rather than suggesting the desirability of the modifications made by the Examiner, the prior art actually teaches away from the modifications and the Examiner has not met his burden of establishing obviousness.

CLAIMS 27 - 29

The Examiner has not separately addressed Claims 27 - 29 in his response, notwithstanding the fact that these claims are based upon a different ground of rejection than those discussed above.

Claims 27 - 29 depend from Claim 25 and distinctly claim a different bag-opening weakening means. Claims 27 through 29 differ from Claim 25 by more distinctly claiming different aspects of the bag-weakening means of Claim 25. In rejecting these claims, the Examiner was forced to find two additional references, ultimately combining five different references in his effort to recreate Applicant's invention.

As noted above, all parties agree obviousness can only be established where there is some teaching, suggestion, or motivation to do so within either the prior art or in knowledge generally available to one of ordinary skill in the art. In rejecting Claims 27 - 29, the Examiner has combined five references and simply argues, without any citation to the referenced prior art, that these five references somehow combine to teach Applicant's invention. Rather than consider the totality of each cited reference, the Examiner has selected references which happen to contain individual elements of the Applicant's claims and then argued that each element of the claims is

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found within the prior art. A finding of obviousness requires more. *See, Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1575 (Fed. Cir. 1987).

CLAIMS 32 and 34

The Examiner's continued rejection of these claims fails for the same reasons as his rejection of Claim 25 and its progeny fails. He has not offered any evidence the prior art references combine to teach Applicant's invention and he has selected elements of the invention from the prior art.

The Examiner again relies upon Morris, McEachen and Theed and continues to argue, without citation, that wraps and bags are interchangeable packages. As shown above, the prior art actually teaches that wraps and bags are not interchangeable packages and that each functions in a completely different manner. The references fairly teach away from the combination the Examiner now suggests is obvious.

CLAIMS 33 and 35

Claims 33 and 35 add limitations regarding the form of the inner bag. While not grouped in this manner by the Examiner, Applicant suggests these claims can be fairly grouped with Claims 27 – 29, in that each claim has been rejected by the Examiner's selection of four or more prior art references containing different limitations of Applicant's claim. As with the earlier claims, the Examiner has made no effort to show where the prior art teaches or suggests Applicant's claimed invention.

Conclusion

Applicant's claimed inventions contain many features that have neither been taught nor suggested by the prior art. Rather than suggesting the combination of elements claimed by Applicant, the prior art fairly teaches that wrappings and bags are different forms of packaging with different functions. Because the prior art teaches away from the various substitutions

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suggested by the Examiner, his final rejections should be reversed and the pending claims should be allowed.

Respectfully submitted,

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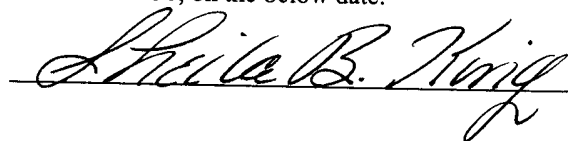


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